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IN THE

Supreme Court of the United States

OCTOBER TERM, 1941

No. 965

GENZO SHIMADZU and NORTHEASTERN ENGINEERING CORPORATION,
Petitioners,

v.

THE ELECTRIC STORAGE BATTERY CO.,
Respondent.

PETITIONERS' REPLY TO RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

GEO. WHITEFIELD BETTS, JR.,
Counsel for Petitioners.

GEORGE H. SOUTHER,
GEORGE YAMAOKA,
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The inferences drawn by respondent on pages 3 to 5 of its brief, based on the quotation from this Court's opinion, to the effect that the District Judge in his last opinion put aside the law of the case in holding that U. S. Patent 1,584,149 involves oxidation and temperature control are best answered by the following quotation from the opinion after remand of the District Judge himself.

> "Specifically, I do not think that the Supreme Court meant to hold that '149 did not disclose heat and oxidation.
>
> Besides, if the sentence was intended to mean what the defendant says it does, 'merely' would be a misplaced modifier. The Court said that the patent covered 'merely a process.' Several of the patents

in suit claimed product and apparatus as well as process. The Court did not say, 'Its claims cover a process for the production of * * * powder merely by introducing * * * etc. * * *' or '* * * merely blowing the powder from the vessel by a current of air.' The distinction in meaning is apparent.

Concededly, '150 teaches the use of air and heat for the purpose of oxidation. So far as the testimony in this case is concerned, I do not find any expression of opinion on the part of the defendant's experts that '149 differs from it in that particular. Dr. Woodbridge, the defendant's chief engineer and an expert, said, 'In United States patent 1,584,150 a temperature between 60° and 200° C. is mentioned. In U. S. patent 1,584,149 no mention is made of temperature in the process, but in my opinion, as a result of the process described, the elevated temperature within the limits specified in U. S. patent 1,584,150 would unquestionably arise.' And again, 'I do not find in either patent 149 in suit or in Exhibits 111 and 112 any limitation upon the amount of oxidation which might take place in either of those three patents'' (Vol. IV, 1443).

That U. S. '149 did involve oxidation and elevated temperature was one point on which the experts on both sides agreed.

Respondent's argument at the foot of page 8 of its brief that petitioners' first reason for the allowance of the writ, ''is, in effect, that the Courts below were not at liberty, under the decision of this Court, to consider the validity of the claims of Patent 1,584,149 under R. S. 4887 by reason of Japanese Patents 41,728 and 42,563'' and overlooks the fact that the case was remanded with express direction ''to determine whether 1,584,149 is valid and infringed,'' itself overlooks the fact that one question bearing on validity was

admittedly decided by this Court, to wit: That '149 was not invalidated by two years' prior public use.

Respondent also has overlooked the fact that this Court in its opinion (R. IV, 1279) referred to the fact that the respondent, then petitioner, had "pleaded that earlier patents procured by Shimadzu in Japan avoided the United States patents as the former were for the same inventions and each was granted more than a year prior to the filing of the corresponding application in this country," and went on to say that the District Court found the facts which the Circuit Court of Appeals affirmed, evidently, it is believed, treating this question as settled. It was not one of the three questions submitted for certiorari.

Respondent's argument at the top of page 9 that the second reason urged by petitioners for the allowance of a writ of certiorari is based on the third reason assigned for the granting of the writ in the petition filed by The Electric Storage Battery Company when the case was here before (No. 441, October Term, 1938) which dealt with the defense of concealment and abandonment, and that the argument on that point pertained only to U. S. '150 and U. S. '020 and not to U. S. '149, is best answered by its 10th assignment of error, found on page 10 of its brief on argument in this Court reading as follows:

> "(10) In not holding that the claims of patents Nos. 1,584,149, 1,584,150 and 1,896,020, adjudged valid and infringed, are invalid because the inventions of said claims were suppressed and concealed by Shimadzu for more than two years after the subject-matter of said claims had been known and used commercially by others in this country."

and by its argument under Point II of that brief (pp. 28-31) in which U. S. '149 is specifically mentioned, culmi-

nating on page 31 with the statement quoted by the present petitioners in Point II of their brief in support of the application for a writ on page 26.

Respondent's reference on page 12 of its brief to the fact that petitioners sought in this case heretofore to have U. S. '150 adjudged entitled to the filing date of U. S. '149 is best answered by the fact that at that time the two lower courts had not yet held that U. S. '150 and U. S. '149 were for the same invention.

Both respondent and the Circuit Court of Appeals on the second appeal overlooked completely the third step of Claim 2 of U. S. '149 which consists of "introducing a current of air into said vessel" after the rotation of the vessel with the lumps of lead in it and before the forming of the lead powder by attrition, which step was completely absent from Japanese patents '728 and '563 (R. III, 1222).

March 16, 1942.

Respectfully submitted,

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